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October 10, 2000

Director of Technology Center 3600
Assistant Commissioner for Patents
Washington, D.C. 20231

Attn: Art Unit 3651
Patent Examiner Michael E. Butler

Re:

Application Serial No.:	**09/086,857**
Applicants:	**David T. Frederick, et al.**
Title:	**System For Tracking And Dispensing Medical Items From Environmentally Controlled Storage Area**
Docket No.:	**D-1093**

Sir:

Please find enclosed Applicants' Petition For Withdrawal of Restriction Requirement Pursuant to 37 C.F.R. § 1.144 for filing in the above case. Pursuant to 37 C.F.R. § 1.181, no fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with this Petition and any other fee due to Deposit Account 04-1077.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	**David T. Frederick, et al.**	Art Unit:	**3651**
Serial No.:	**09/086,857**	Patent Examiner	**Michael E. Butler**
Filed:	**May 29, 1998**		
For:	**System For Tracking And Dispensing Medical Items From Environmentally Controlled Storage Area**		

Director of Technology Center 3600
Assistant Commissioner for Patents
Washington, D.C. 20231

PETITION FOR WITHDRAWAL OF RESTRICTION REQUIREMENT PURSUANT TO 37 C.F.R. § 1.144

Sir:

Applicants respectfully petition for withdrawal of the restriction requirement presented in the above referenced application in the Office Action ("Action") dated December 3, 1999. Reconsideration of the restriction requirement was requested pursuant to 37 C.F.R. § 1.143 on December 30, 1999. The request for reconsideration of the restriction requirement was denied in the Office Action dated March 14, 2000. However, the Patent Office in the Action dated March 14, 2000 did grant Applicants' request for withdrawal of the election of species requirement.

Applicants respectfully submit that the restriction requirement should be withdrawn as it is legally improper.

In the Action claims 1-44 were made subject to a restriction requirement. In the request for reconsideration of December 30, 1999, Applicants provisionally elected with traverse Grouping I (claims 1-3 and 24-26). Applicants filed an amendment with additional claims 45-47 on May 23, 2000. These claims 45-47 were grouped with Grouping I in the Office Action dated August 16, 2000. Thus, Grouping I now includes claims 1-3, 24-26, and 45-47.

Applicants respectfully submit that the restriction requirement is not valid, nor is the asserted basis for the restriction a valid basis for requiring restriction. Applicants respectfully request that the restriction requirement be withdrawn and that all of the claims 1-47 be examined.

The Definitions of the Groups Are Improper

Group II

The Action indicates Group II as drawn to "a rotary locking mechanism." However, all of the Group II claims are directly or indirectly dependent on claim 1, which has been placed in Group I. Claim 1 is drawn to a system for providing medical items, comprising a computer, user interface, refrigerator, and lock module. Hence, Group II is drawn to more than "a rotary locking mechanism." Therefore, the restriction requirement is based on an improper Group II definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group III

The Action indicates Group III as drawn to "a system for attaching a locking mechanism to a refrigerator door." However, all of the Group III claims are directly or indirectly dependent

on claim 1, which has been placed in Group I. Claim 1 is drawn to a system for providing medical items, comprising a computer, user interface, refrigerator, and lock module. Hence, Group III is drawn to more than "a system for attaching a locking mechanism to a refrigerator door." Therefore, the restriction requirement is based on an improper Group III definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group IV

The Action indicates Group IV as drawn to "a system for reading identification indicia into a computer." However, all of the Group IV claims are directly or indirectly dependent on claim 1, which has been placed in Group I. Claim 1 is drawn to a system for providing medical items comprising a computer, user interface, refrigerator, and lock module. Hence, Group IV is drawn to more than "a system for reading identification indicia into a computer." Therefore, the restriction requirement is based on an improper Group IV definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group V

The Action indicates Group V as drawn to "a locking module with self return mechanism." However, all of the Group V claims are directly or indirectly dependent on claim 1, which has been placed in Group I. Claim 1 is drawn to a system for providing medical items comprising a computer, user interface, refrigerator, and lock module. Hence, Group V is drawn to more than "a locking module with self return mechanism." Therefore, the restriction

requirement is based on an improper Group V definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group VII

The Action indicates Group VII as drawn to "a method for attaching an access controlled locking mechanism to the dispenser." However, all of the Group VII claims are directly or indirectly dependent on claim 27, which has been placed in Group VI. Claim 27 is drawn to a method comprising the steps of attaching a lock module; placing a medical item; storing in a data store data; inputting through an input device an input; determining with a computer; generating a signal with the computer; and enabling access. Hence, Group VII is drawn to more than "a method for attaching an access controlled locking mechanism to the dispenser." Therefore, the restriction requirement is based on an improper Group VII definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group VIII

The Action indicates Group VIII as drawn to "a method for locking a door." However, all of the Group VIII claims are directly or indirectly dependent on claim 27, which has been placed in Group VI. Claim 27 is drawn to a method comprising the steps of attaching a lock module; placing a medical item; storing in a data store data; inputting through an input device an input; determining with a computer; generating a signal with the computer; and enabling access. Hence, Group VIII is drawn to more than "a method for locking a door." Therefore, the

restriction requirement is based on an improper Group VIII definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Alleged Groups Are Not Distinct

Groups I and VI/VIII Are Not Distinct

The apparatus (Group I) has not been shown to practice another and materially different process

The Action asserts that Groups I and VI/VIII are related as apparatus and process for its practice. The Action further indicates that the Groups I and VI/VIII are distinct because "the apparatus or I may be used to vend beverages."

Applicants respectfully disagree. The Action has directed Group I to "an access controlled refrigerated medicine storage and dispensing device." The Action has directed Group VI (and Group VIII whose claims depend on Group VI) to "a method for controlling a refrigerated medicine storage and dispensing device." Therefore, the Office has admitted in the Action that the apparatus of Group I is clearly directed to the process of Groups VI/VIII. It is not proper for the Action to admit that the apparatus of Group I is directed to a "medicine storage and dispensing device" for restriction purposes, and then directly contradict that admittance by alleging that this same apparatus (Group I) can "be used to vend beverages." Therefore, the Action has not shown that the apparatus of Group I "can be used to practice another and materially different process", as is required (MPEP 806.05(e)). On this basis it is respectfully

submitted that the restriction requirement should be withdrawn.

Furthermore, the Group I claims are clearly directed to and have the structure for "providing medical items" (claim 1). The Group I claims further recite "item data representative of a plurality of medical items" (claim 1). Applicants request evidence of a process of "vending beverages" using all of the recited features in the apparatus of Group I. That is, Applicants ask for evidence showing a beverage vending machine using a computer in operative connection with a data store, wherein the data store includes user data representative of a plurality of authorized users, wherein responsive to a user inputting identification data through an input device of a user interface corresponding to data representative of an authorized user, the computer enables the user to input medical item indicia corresponding to a medical item, and wherein the computer is operative to output a signal changing the lock module to an unlocked condition. Beverage vending machines are designed to be available to the public. Beverage vending machines are not limited to only authorized users, as recited in all of the claims of Group I. Nor do they require the input of identification data corresponding to one of these authorized users for their use, in the manner recited in Group I. It follows that the Action's alleged "another and materially different" use (beverage vending) for Group I is highly unreasonable.

Furthermore, the economics of beverage vending machines is to use low-cost machines because the products sold are low cost. The alleged beverage vending machine would not be permitted to use such an elaborate (security) system as recited in Group I.

The burden is on the Patent Office to provide a reasonable example (MPEP 806.05(e)). The Action has not shown any reasonable example of how the recited apparatus of Group I "may

be used to vend beverages." Since the Office has not provided Applicants with a reasonable example, the restriction should be withdrawn. Also, because the Action does not apply the required reasoning for the alleged restriction between Groups I and VI/VIII, Applicants have been required to unfairly speculate as to possible rationales for the baseless restriction.

Again, Applicants challenge the assertions in the Action and request that the Patent Office provide evidence showing a beverage vending machine having the features recited in Group I, including a computer in operative connection with a data store having data representative of authorized users, input of medical item indicia, and a lock module. If the Patent Office does not provide such evidence, then the restriction should be withdrawn because it is clearly not reasonable.

"If Applicant proves or provides convincing argument that there is no material difference or in the case of a process that cannot be preformed by hand (if examiner so argued), the burden is on the examiner to document another materially different process or apparatus or withdraw the requirement" (MPEP 806.05(e)). Applicants, in the reasons presented above, have shown that the apparatus as claimed cannot be used to practice the process alleged as the basis for restriction. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Nevertheless, even if it were possible for Group I to "vend beverages" as alleged by the Office, then how is this process "another and materially different" process from the process of Group VI? The Action admits that both Group I and Group VI are directed to "medicine storage and dispensing." Therefore, if the "medicine storage and dispensing"directed to Group I can be used to "vend beverages" as alleged by the Office, then it follows that the "medicine storage and

dispensing" directed to Group VI can also be used to "vend beverages". In other words, what exact claim language prevents Group VI from also "vending beverages"? If nothing in Group VI prevents it from vending beverages, then it must be capable of such. It follows that if Group I is capable of "vending beverages", then so is Group VI. Therefore, Groups I and VI are not distinct. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The process (Group VI) has not been shown to be practiced by another materially different apparatus or by hand

The Action also states that "process VI may be used to recognize the presence of medical inventory within a storage location."

Applicants respectfully disagree. The Patent Office is required to show that the process of Group VI "can be practiced by another materially different apparatus or by hand." The Action has merely asserted that the process of Group VI can be used in another process, e.g., "to recognize the presence of medical inventory within a storage location." The Action has not shown any example of the Group VI process practiced by a materially different apparatus from that of Group I. Hence, the Action has not met the basic requirements for a proper restriction between Group I and Group VI. Furthermore, is unclear how the "process" of Group VI can be used in another "process" as alleged. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group I is capable of recognizing "the presence of medical inventory within

a storage location." Group I clearly recites that "a storage location for at least one medical item is stored in an interior area of the refrigerator" (e.g., claim 1). For a proper restriction requirement the Patent Office is required "to provide reasonable examples that recite material differences", not commonality (MPEP 806.05(e)).

Furthermore, what specific language in Group I prevents Group I from being "used to recognize the presence of medical inventory within a storage location?" There isn't any. Hence, Group I is capable of the alleged different use of Group VI. Therefore, the Action has not shown that the process of Group VI "can be practiced by another materially different apparatus or by hand", as is required (MPEP 806.05(e)).

The process (Group VIII) has not been shown to be practiced by another materially different apparatus or by hand

The Action also states that "process VIII may be used to a lock to a house, office, or vault."

Applicants respectfully disagree. Group VIII consists of dependent claims 39-40, both of which directly or indirectly depend on independent claim 27, which belongs to Group VI. Therefore, the same arguments used against the restriction regarding Group I and Group VI are herein incorporated by reference.

Furthermore, the Patent Office is required to show that the process of Group VIII "can be practiced by another materially different apparatus or by hand." The Action has merely stated that the process of Group VIII can be used in another process, e.g., "may be used to a lock to a

house, office, or vault." Hence, the Action has not met the basic requirements for a proper restriction between Group I and Group VIII. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group VIII is not capable of the use alleged in the Action. As previously stated, Group VIII consists of dependent claims 39-40, both of which directly or indirectly depend on independent claim 27, which belongs to Group VI. The Action has already admitted that Group VI is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Hence, Group VIII is also directed to that method. Therefore, Group VIII cannot be "used to a lock to a house, office, or vault." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, the Action has already admitted that Group I is directed to "an access controlled refrigerated medicine storage and dispensing device." Therefore, the process of Group VIII is directed to the apparatus of Group I. Therefore, the Action has not shown that the process of Group VIII "can be practiced by another materially different apparatus or by hand", as is required (MPEP 806.05(e)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and II-V Are Not Distinct

The Action indicates that Group I and Groups II-V are related as combination (Group I) and subcombinations (Group II-V).

Applicants disagree. In order to establish that combination and subcombination

inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The Patent Office must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations. The Action alleges that the combination as claimed does not require the particulars of the subcombination and that the subcombination has separate utility.

This allegation is without legal basis. Groups II-V contain no independent claims. Each of the claims in the alleged subcombinations (Groups II-V) is a dependent claim that is directly or indirectly dependent on independent claim 1 (Group I). Therefore, each of the Groups II-V is dependent on and includes the subject matter of claim 1 (Group I). All of the claims in Groups II-V depend from Group I.

It is not proper to allege an independent claim as a combination, and claims which depend from said independent claim (i.e., dependent claims) as subcombinations. The dependent claims of Groups II-V by definition have more features than their independent claim of Group I. Clearly, it is the dependent claims, by having more subject matter, which constitute the "combination" instead of the "subcombinations" as alleged. Furthermore, it is the independent claim of Group I that constitutes the subcombination. Therefore, the requirement that (A) the combination as claimed does not require the particulars of the subcombination can never be met, because the combination (in reality the dependent claims of Group II-V) always require the particulars of the independent claim 1 (Group I). If, as alleged by the Office, the independent claims were the combination and the dependent claims the subcombination, then it would appear

that every application having dependent claims would be restrictable. Clearly, this is not proper.

Nevertheless, even if it were possible for claim 1 to be drawn to a combination (Group I), as alleged in the Action, then each of the claims in the Groups II-V would include the same combination as claim 1. Therefore, each of the Groups II-V would include the same alleged combination as Group I. As a result the Groups II-V would automatically include the utility of Group I.

Furthermore, Group I (independent claim) is actually broader than any of the Groups II-V (dependent claims). Therefore, Group I can match any utility that the Groups II-V may have. The allegation in the Action that the dependent claim subcombinations (Groups II-V) have "separate utility" (apart from the independent claim combination) is in error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Also, the Action has not shown that each alleged subcombination has utility by itself or in other combinations, as is required (MPEP 806.05(c)). How are the Groups II-V distinct from each other? Since this has not been shown, the alleged inventions are not distinct (MPEP 806.05(c)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and VII Are Not Distinct

The Action states that "Inventions I and VII are related as process of making and product made" (MPEP 806.05(f)).

Applicants disagree. The Action has directed Group I to "an access controlled

refrigerated medicine storage and dispensing device." Group I is already directed to an apparatus. Hence, Group I is not directed to "a process of making" as alleged by the Office. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Group VII consists of dependent claims 28-30, which directly or indirectly depend on independent claim 27, which belongs to Group VI. The Action has directed Group VI to "a method for controlling a refrigerated medicine storage and dispensing device." Hence, Group VII is also directed to said method. Group VII is not directed to a "product made." On this basis it is respectfully submitted that the restriction requirement should be withdrawn. Furthermore, neither Group I nor Group VII is directed to a "product made."

The Action further states that the "process may be used to attach a lock to an office or house." Applicants disagree. The Patent Office is required to show that the process of Group VII "can be practiced by another materially different apparatus or by hand." The Action has merely asserted that the process of Group VII can be used in another process, e.g., "used to attach a lock to an office or house." Hence, the Action has not met the basic requirements for a proper restriction between Group I and Group VII. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group VII is not capable of the alleged use. The Action has already directed Group VII to "a method for attaching an access controlled locking mechanism to the dispenser." Therefore, Group VII cannot be "used to attach a lock to an office or house." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Also, as previously stated, Group VII consists of dependent claims 28-30, which directly

or indirectly depend on independent claim 27, which belongs to Group VI. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Hence, Group VII is also directed to such a method. Therefore, Group VIII cannot be "used to attach a lock to an office or house." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, the Action has directed Group I to "an access controlled refrigerated medicine storage and dispensing device." Therefore, the process of Group VII is directed to the apparatus of Group I. The Patent Office has not shown that the process of Group VII "can be practiced by another materially different apparatus or by hand", as is required (MPEP 806.05(e)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn..

Groups II, III, IV and V Are Not Distinct

The Action alleges separate utility among the Groups II, III, IV, and V.

Applicants disagree. "The Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Care must be taken to determine if the subcombinations are generically claimed." (MPEP 806.05 (d)).

As previously argued, each of the claims in the alleged subcombinations (Groups II-V) is a dependent claim that is directly or indirectly dependent on independent claim 1 (in alleged combination Group I). Therefore, each of the Groups II-V is dependent on and includes the common subject matter of claim 1 (Group I). Therefore, each of the Groups II-V includes the same utility as Group I. None of the subcombinations has utility other than in the disclosed

combination. Therefore, it cannot be shown that the alleged subcombinations have utility other than in the alleged combination, as is required to sustain the restriction requirement. The Action has acknowledged Group I is directed to "an access controlled refrigerated medicine storage and dispensing device." Therefore, the allegation in the Action that the subcombinations (Groups II-V) have "separate utility" is in error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

"If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." (MPEP 806.05 (d)). Applicants, in the reasons presented above, have shown that the alleged "separate utility" cannot be accomplished and is not reasonable. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups VI and VIII Are Not Distinct

The Action alleges that Groups VI and VIII are related as combination and subcombination. The Action states that the combination (VI) does not require the particulars of the subcombination because "the dispensing of medicine and monitoring of inventory do not require a locking mechanism." The Action also states that the subcombination (VIII) has "separate utility such as locking the door of a safe."

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The

Patent Office must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations.

The allegation in the Action is without legal basis. It is not proper to allege an independent claim as a combination and claims which depend from that same independent claim (i.e., dependent claims) as a subcombination. The Office has it backwards. As previously discussed, at best it is the dependent claims (Group VIII) which constitute the combination and the independent claim (Group VI) which constitutes the subcombination.

Each of the claims in the alleged subcombination (Group VIII) is a dependent claim that is directly or indirectly dependent on independent claim 27 (Group VI). Therefore, Group VIII is dependent on and includes the subject matter of claim 27 (Group VI). Therefore, each of the claims in Group VIII includes the same alleged combination as recited in claim 27. Therefore, Group VIII includes the same alleged combination of Group VI. That is, the alleged subcombination includes the alleged combination. Therefore, Group VIII automatically includes the utility of Group VI. Group VI is actually broader than Group VIII. Therefore, Group VI can match any utility that Group VIII may have. The allegation in the Action that the alleged subcombination (Group VIII) has "separate utility" (apart from the alleged combination) is in error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group VIII is not capable of the alleged use. The Action has directed Group VI to "a method for controlling a refrigerated medicine storage and dispensing device."

Group VIII, by being dependent on Group VI, is also directed to said method. Therefore, Group VIII cannot be used as "a method for locking a door." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

As previously discussed, if the Office is wrongly permitted to restrict the dependent claims (Group VIII) from the independent claim (Group VI) then it would appear that every application having dependent claims would be restrictable.

Groups VII and VIII Are Not Distinct

The Action alleges that Groups VII and VIII are related as subcombinations.

Applicants disagree. "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Care must be taken to determine if the subcombinations are generically claimed." (MPEP 806.05 (d)).

The Action provides no such showing or example. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, each of the claims in the alleged subcombinations (Groups VII and VIII) is a dependent claim that is directly or indirectly dependent on independent claim 27 (Group VI). Each of the Groups VII and VIII is dependent on and includes the common subject matter of claim 27 (Group VI). Therefore, each of the Groups VII and VIII includes the same utility as Group VI. None of the alleged subcombinations has utility other than in the alleged combination. The Action has acknowledged that Group VI is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Therefore, the allegation in

the Action that the subcombinations (Groups VII and VIII) have "separate utility" is in error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

"If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." (MPEP 806.05 (d)). Applicants, in the reasons presented above, have shown that the alleged "separate utility" cannot be accomplished and is not reasonable. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups VI and VII Are Not Distinct

The Action alleges that Groups VI and VII are related as subcombinations.

Applicants disagree. "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. Care must be taken to determine if the subcombinations are generically claimed." (MPEP 806.05 (d)).

This allegation is without legal basis. It is not proper to allege an independent claim as a subcombination and the claims which depend from this same independent claim (i.e., dependent claims) also as a subcombination. How can an independent claim and a claim dependent thereon both be subcombinations and distinct?

Each of the claims in the alleged Group VII subcombination is a dependent claim that is directly or indirectly is dependent on and includes the common subject matter of claim 27 (Group VI). Therefore, Group VII includes the same utility as Group VI. Therefore, the Group VII

subcombination does not have separate utility from the Group VI subcombination. Nor does the Group VI subcombination have separate utility from the Group VII subcombination. Group VI, as admitted in the Action, is directed to "a method for controlling a refrigerated medicine storage and dispensing device." Therefore, the allegation that Group VI and Group VII are subcombinations having "separate utility" is in error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action also states that "invention VI has separate utility such as a dispenser of medicine." Applicants disagree. The alleged utility would not be "separate." As previously discussed, Group VII (which is dependent on Group VI) would also have "utility such as a dispenser of medicine."

The Action also states that "invention VII has separate utility such as the mechanical attachment of subsystems to each other." Applicants disagree. As previously discussed, Group VI (from which Group VII depends and is broader in scope) would also be capable of such utility.

The Action also states that "the product may be dispensed without utilizing a processor or terminal or without comparing id codes." Applicants disagree. What product? The Action has not stated which Group is directed to the alleged "product." Nevertheless, as previously discussed, since Group VII is dependent on Group VI, they would have the same utility.

"If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." (MPEP 806.05 (d)).

Applicants, in the reasons presented above, have shown that the alleged "separate utility" cannot be accomplished and is not reasonable. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups I and III Are Not Distinct

The Action alleges that Groups I and III are related as combination and subcombination.

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The Patent Office must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations.

As previously discussed, Groups I and III are not distinct. Nor can the independent claim in Group I be the combination to the dependent claims in Group III. The Office has it backwards, at best the dependent claims of Group III would be the combination, not a subcombination as alleged.

Additionally, each of the claims in the alleged subcombination (Group III) is a dependent claim that is directly or indirectly dependent on independent claim 1 (Group I). Therefore, Group III is dependent on and includes the subject matter of claim 1 (Group I). The Action alleged that claim 1 is drawn to the combination (Group I). Even if this were true, the claims in Group III include the same alleged combination of claim 1. Hence, Group III would include the same alleged combination of Group I. Therefore, the alleged subcombination would include the

alleged combination. Therefore, Group III automatically includes the utility of Group I. Group I (having the independent claim) is actually broader than Group III (having dependent claims). Therefore, Group I can match any utility that Group III may have. The allegation in the Action that the alleged subcombination (Group III) has "separate utility" (apart from the alleged combination) is in error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action has not shown that alleged subcombination has utility by itself or in other combinations, as is required (MPEP 806.05(c)). Since this has not been shown, the alleged inventions are not distinct (MPEP 806.05(c)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group III is not capable of the alleged use. The Action has already directed Group III to "a system for attaching a locking mechanism to a refrigerator door." Therefore, Group III cannot be used as "a transaction logger and a characteristic profiler for recipients of the sample." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups II and IV Are Not Distinct

The Action alleges that the Groups II and IV are related as combination and subcombination.

Applicants disagree. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated (MPEP 806.05(c)). The

Action must show both (A) that the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (B) that the subcombination has utility by itself or in other combinations.

Each of the claims in the alleged combination (Group II) and subcombination (Group IV) is a dependent claim that is directly or indirectly dependent on independent claim 1 (Group I). Therefore, both Group II and Group IV each are dependent on and include the subject matter of claim 1 (Group I). To state that Group II is a combination, and Group IV is a subcombination is improper.

Furthermore, Group II can match any utility that Group IV may have. Therefore, the allegation that the subcombination (Group IV) has "separate utility" is in error. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

What specific language in Group II prevents Group II from being used as "a transaction logger and a characteristic profiler for recipients of the sample?" There isn't any. Therefore, the Action has not shown that the alleged subcombination of Group IV has "separate utility", as is required (MPEP 806.05(c)). On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group IV is not capable of the alleged use. The Action has already directed Group IV to "a system for reading identification indicia into a computer." Therefore, Group IV cannot be used as "a transaction logger and a characteristic profiler for recipients of the sample." On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups III and IV Are Not Distinct

The Action alleges that the Groups III and IV are related as process and apparatus for its practice (MPEP 806.05(e)).

Applicants disagree. Applicants are not pleased that they have to rebut Group III as a process when Group III is clearly a system. However, this is just another example of the Office's incorrect interpretations of the Groupings as applied throughout the restriction requirement.

The Action has already admitted that Group III is directed to "a system for attaching a locking mechanism to a refrigerator door." The Action has further admitted that Group IV is directed to "a system for reading identification indicia into a computer." Therefore, neither Group III nor Group IV is directed to a "process", as alleged in the Action. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Action Lacks Examples Of Distinctness Between All Alleged Groups

Groups II and VI are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups II and VI. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups II and VII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged

Groups II and VII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups II and VIII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups II and VIII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups III and VI are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups III and VI. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups III and VII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups III and VII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups III and VIII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups III and VIII. Therefore, restriction of said alleged Groups is improper. On this basis it is

respectfully submitted that the restriction requirement should be withdrawn.

Groups IV and VI are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups IV and VI. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups IV and VII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups IV and VII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups IV and VIII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups IV and VIII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups V and VI are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups V and VI. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups V and VII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups V and VII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups V and VIII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups V and VIII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Groups VII and VIII are not distinct

The Action has not shown, by way of any example, distinctness between the alleged Groups VII and VIII. Therefore, restriction of said alleged Groups is improper. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Additional Comments

The Actions's attempt to restrict a claim (e.g., dependent claim 4 of Group II) which is directly dependent on an independent claim (e.g., independent claim 1 of Group I) from the independent claim is without merit. On a larger scale, none of the Groups II-V (having dependent claims) are distinct from Group I (having the independent claim). Nor are any of Groups VII-VIII (having dependent claims) distinct from Group VI (having the independent

claim). Therefore, the restriction requirement should be withdrawn.

Furthermore, the Actions's attempt to call an independent claim the combination and the dependent claim the subcombination in a combination/subcombination relationship is without merit. 37 CFR 1.75(c) indicates that "One or more claims may be presented in dependent form, referring back to and further limiting another claim." It is well known that a dependent claim comprises all of the features of its independent claim plus an additional feature. It is further well known that a combination comprises the subcombination. Therefore, how can an independent claim be a combination and its dependent claim be only the subcombination? The restriction requirement is based on this falsehood. This improper interpretation of combination/subcombination relationships is reflective of the entire restriction requirement. Therefore, the restriction requirement should be withdrawn.

Rejoinder

The Action has not addressed the issue of rejoinder of claims. Rejoinder should be addressed in view of independent and dependent claims being in different Groups; the alleged combination/subcombinations; and product and process claims (e.g., Groups I/VII; and mentioned in Groups VI/VII). Therefore, the restriction requirement should be withdrawn.

The Action Is Unclear

The restriction requirement does not provide clear examples distinguishing the Groups as independent and distinct from each other. The Action leaves Applicants the undue burden of

responding to confusing, contradicting, and improper requirements. On this basis it is respectfully submitted that the requirements should be withdrawn.

Furthermore, the Office has not given straightforward and clear restriction requirements based on the laws, regulations, and Office procedures. The Office's improper requirements appear to be a failed attempt to puzzle together non fitting restriction and species pieces. The Office has also tried to obfuscate the issue, because there is no proper restriction requirement to be made. On this basis it is respectfully submitted that the requirements should be withdrawn.

The Restriction Requirement Is Without Legal Basis

Applicants additionally respectfully wish to point out that the Action fails to state a legally proper test for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both "independent" and "distinct." The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are "distinct." There are no assertions that the sets of claims are "independent", as is required. This standard does not comply with the statutory requirements. Therefore the reasons asserted in the Action for

seeking to impose the restriction requirements are legally insufficient due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder.

Furthermore, the Patent Office has acknowledged that before claimed inventions can be considered to be "independent" the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. All the claims directed to Applicants' invention are related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Additional Remarks In Response To The Comments
In The Office Action Dated March 14, 2000

In the Office Action dated March 14, 2000 ("Office Action") that was issued in response to the request for reconsideration, it was asserted that the restriction was proper. The same Office Action also indicated that "Groups I and VI claim combinations of subcombinations. By contrast the claims of groups II-V and VII-VIII detail particulars of the subcombinations which were combined to form the claimed inventions of each of the combination groups I and VI."

With all due respect, this explanation is incomprehensible and inaccurate. How is Group I, which includes the independent claim, a "combination of subcombinations"? Also, how are Groups II-V "combined to form" the claimed invention of Group I? As previously discussed, for example, Group I (containing the independent claim) cannot be a combination of Group II (containing a direct dependent claim). At best, it is Group II, which encompasses Group I, which would be the combination. Therefore, the basis of the restriction requirement is completely

backwards and without basis. The criteria of distinctness for combination and subcombination does not directly apply to independent/dependent claims, because they are not restrictable. Nevertheless, for example purposes, in attempting to apply ABsp/Bsp in the criteria of distinctness for combination and subcombination, "Bsp" would correspond to independent claim 1 (Group I) and "ABsp" would correspond to its dependent claim 4 (Group II). Clearly, restriction is not permitted.

The same Office Action also incomprehensibly indicated that "The subcombinations claimed in of groups II-V and VII-VIII may readily be interchanged with equivalents and still constitute the same claimed invention with respect to the combination groups I and VI. As applicant did not include the details of the subcombination within the independent claims, one clearly sees that the particulars of the specific subcombinations are not essential in the operation of the combinations, and that the applicant deemed protection of the combination sufficiently important to warrant protection separately from the protection of the particulars of the subcombination." It appears the Office Action indicates that the "subcombinations claimed in groups II-V and VII-VIII" "constitute the same claimed invention with respect to the combination groups I and VI." Therefore, if the subcombinations constitute the same claimed invention, as the Office Action has admitted, then please explain why there is a restriction requirement?

The same Office Action on page 3, in regard to Group II, indicates that "The applicant has detailed particulars of the locking mechanism in the claims such a pawls, pivoting levers, cylinders. Such elements comprises a separate and distinct inventive technology and area of expertise from the refrigerated medicine storage and dispensing device."

However, what this Office Action failed to consider is that all of the claims in Group II are dependent on the independent claim in Group I. These Group II dependent claims include all of the features of the Group I independent claim. Therefore, Group II encompasses Group I. Furthermore, in the Action dated December 3, 1999, Group I was defined as "an access controlled refrigerated medicine storage and dispensing device." Thus, the Group II claims also inherently include "an access controlled refrigerated medicine storage and dispensing device." Therefore, how can Group II comprise "a separate and distinct inventive technology and area of expertise from the refrigerated medicine storage and dispensing device" when, as admitted by the Action, it includes "an access controlled refrigerated medicine storage and dispensing device"? It likewise follows that the other Groups III-V (claims 12-23) do not comprise "a separate and distinct inventive technology and area of expertise from the refrigerated medicine storage and dispensing device."

Furthermore, in the Action dated December 3, 1999, Group VI was defined as "a method for controlling a refrigerated medicine storage and dispensing device." However, the dependent claims in Groups VII-VIII include all of the features of the Group VI independent claim. It likewise follows that the Groups VII-VIII (claims 28-30 and 39-40) do not comprise "a separate and distinct inventive technology and area of expertise from the refrigerated medicine storage and dispensing device."

In paragraph 5 of the Office Action states that "process VI may be used to recognize the presence of medical inventory within a storage location." Applicants respectfully disagree. The Patent Office is required to show that the process of Group VI "can be practiced by another

materially different apparatus or by hand." The Action has merely asserted that the process of Group VI can be used in another process, e.g., "to recognize the presence of medical inventory within a storage location." The Action has not shown any example of the Group VI process practiced by a materially different apparatus from that of Group I. Hence, the Action has not met the basic requirements for a proper restriction between Group I and Group VI. Furthermore, is unclear how the "process" of Group VI can be used in another "process" as alleged. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

Furthermore, Group I is capable of recognizing "the presence of medical inventory within a storage location." Group I clearly recites that "a storage location for at least one medical item is stored in an interior area of the refrigerator" (e.g., claim 1). For a proper restriction requirement the Patent Office is required "to provide reasonable examples that recite material differences", not commonality (MPEP 806.05(e)).

Furthermore, what specific language in Group I prevents this Group from being "used to recognize the presence of medical inventory within a storage location?" There isn't any. Hence, Group I is capable of the alleged different use of Group VI. Therefore, the Action has not shown that the process of Group VI "can be practiced by another materially different apparatus or by hand", as is required (MPEP 806.05(e)).

The Office Action also states that "the method of group VI may be used with different dispenser" from that of Group I. Where is this allegedly different dispenser? The Office Action has not provided any information on this allegedly "different" dispenser with which the method of Group VI may be used. The Office Action merely states that Group VI "may be used with

different dispenser." This mere statement, without the required showing, is not a proper basis for restriction requirement. Applicants are entitled to know what this allegedly "different" dispenser comprises. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

The Office Action on page 4 indicated that the Applicants somehow misstated some "test of patentably distinct inventions." The Applicants disagree. Applicants' previously argued that beverage vending machines are designed to be available to the public. Beverage vending machines are not limited to only authorized users, as recited in all the claims of Group I. Nor do beverage vending machines require the input of identification data corresponding to one of these authorized users for their use, in the manner recited in Group I. Applicants' also argued that the Action's alleged "another and materially different" use (beverage vending) for Group I was highly unreasonable. It is noted that the Office has not rebutted this argument. Nor has the Office even addressed the Applicants' arguments against the alleged usage of Group I for vending beverages. Therefore, it is concluded that the Office has agreed with the Applicants.

The Office Action's remarks on page 5 have already been previously rebutted by Applicants.

Applicants disagree with the remarks of the Office Action on page 6 regarding "independent and distinct." 35 U.S.C. § 121 clearly requires both "independent and distinct" inventions. The Office's interpretation of any report on the hearings before the committees of Congress is a moot issue. At present the law requires both "independent and distinct" inventions. The Office has not asserted nor shown that the Groups are "independent", as is required by law.

Thus, the statutory requirements are not met and no restriction requirement may be imposed.

Applicants are entitled to a full and complete explanation of any restriction requirement. As discussed above, the Office has not provided Applicants with such. Nor have all of Applicants' arguments and questions been addressed. Therefore, Applicants also petition for the granting of a full and complete explanation of all issues.

Conclusion

For all the foregoing reasons it is respectfully submitted that there is no valid basis for requiring restriction. As the Action failed to specify a valid basis for restriction, it is respectfully submitted that this Petition should be granted and the restriction requirement withdrawn.

Respectfully submitted,

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